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| 10/051,860 | 01/16/2002 | Eric Bergman | 54008.8080.US00 P01-0007 | 1640 |
| 45540 7590 06/29/2009 PERKINS COIE LLP/SEMITOOL PO BOX 1208 SEATTLE, WA 98111-1208 | | | | |
| EXAMINER STINSON, FRANKIE L | | | | |
| ART UNIT 1792 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: ERIC BERGMAN

Application No. 10/051,860
Technology Center 1700

Mailed: June 29, 2009

Before TOI JOHNSON *Review Paralegal*
JOHNSON, *Review Paralegal*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on July 9, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, SUMMARY OF CLAIMED SUBJECT MATTER

Appellant filed an Appeal Brief dated June 8, 2007. The Appeal Brief is not in compliance with 37 CFR § 41.37(c) effective September 13, 2004.

According to 37 CFR § 41.37(c) (v), an Appeal Brief must include the following:

(v) *Summary Of Claimed Subject Matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. < While reference to page and line number of the specification **>requires< somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application. >For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

The “Summary of claimed subject matter” appearing on pages 2-3 of the Appeal Brief filed June 8, 2007 is deficient because it does not separately map independent claims 1, 16 and 35 to the specification. Correction is required.

MPEP § 1205.03 states in part:

(B) When the Office holds the brief to be defective solely due to appellant’s failure to provide a summary of the claimed subject

matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

EXAMINER'S ANSWER
INCONSISTENCIES WITH THE BRIEF

A review of the file finds inconsistencies between the last rejection of record and corresponding sections of the Examiner's Answer as set forth below.

Final Rejection

A review of the Final Rejection mailed on July 28, 2005, finds the following status of the claims: claims cancelled: 2-4, 11 and 19-32, claims allowed: NONE, claims rejected: 1, 5-10, 12-18 and 33-35 and claims withdrawn: NONE. However, claim 34 is not included for review in the Final Rejection.

Appeal Brief

On June 8, 2007, Appellants filed an Appeal Brief. On page 2, under the "Status of Claims" heading, Appellants provided a statement that indicated that claims 1, 5-10, 12-18 and 33-35 are on appeal.

Examiner's Answer

A review of the Examiner's Answer mailed on August 24, 2007, finds that the status of claim 34 is unclear as compared to the Appeal Brief.

Specifically, claim 34 is not included in any statement of rejection for review by the Board of Patent Appeals and Interferences.

Clarification of claim 34 is required.

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed June 8, 2007 defective, as required by 37 CFR § 41.37(d);
- 2) notify the Appellant to submit a "paper" which corrects the Appeal Brief's Summary of Claimed Subject Matter under 37 CFR §41.37(c)(1)(v);
- 3) acknowledge and consider any "paper" submitted by Appellant to correct the Appeal Brief;
- 4) vacate the Examiner's Answer mailed on August 24, 2007;
- 5) issue a corrected Examiner's Answer to clarify the rejection of claim 34 and to correct other sections of the Answer as may be required;

6) include the necessary approval from the TC Director or designee in accordance with MPEP 1207.05, part (B) as may be required for any new grounds of rejection; and

7) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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